

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 10/705,199
Filing Date 11/12/03
Confirmation No. 2923
Applicant Noregin Assets N.V. L.L.C.
Inventorship..... Baar, D.
Group Art Unit 2435
Examiner Debnath, S.
Attorney Docket No. NORE0062
Title: Method and System for Controlling Detail-In-Context Presentations

PRE-APPEAL BRIEF REQUEST FOR REVIEW

To: MS AF
Commissioner of Patents and Trademarks,
P.O. Box 1450
Alexandria, VA 22313-1450

From: Nathan Grebasch (Tel. 509-755-7267; Fax 509-755-7252)
Sadler, Breen, Morasch & Colby, p.s.
422 W. Riverside Avenue, Suite 424
Spokane, WA 99201

The Pre-Appeal Panel is respectfully requested to consider the following issues, which are submitted in accordance with the Pre-Appeal Brief Conference Program Rules. Applicant respectfully requests review of the Final Office Action dated May 12th, 2009 (“Office Action”) including Applicant’s responses thereto. Due to the page limit for this Brief, not all the pending issues are addressed. Applicant reserves the right to pursue these additional issues although not addressed in this brief.

Claims 1-8 and 10-35 stand rejected under 35 U.S.C. §103(a). Applicant traverses the rejection.

- Claims 1, 2, 7, 8, 10-17, and 20-35 stand rejected over U.S. Patent Number 5,638,523 to Mullet et al. (hereinafter, “Mullet”) in view of U.S. Patent Number 6,154,840 to Pebley et al. (hereinafter, “Pebley”).
- Claims 3 and 4 stand rejected over Mullet in view of Pebley, further in view of U.S. Patent Application Publication Number 2003/0196114 naming Brew (hereinafter, “Brew”).

- Claims 18, and 19 stand rejected over Mullet, Pebley, further in view of U.S. Patent Application Publication Number 2002/0087894 naming Foley (hereinafter, “Foley”).

- Claims 5 and 6 stand rejected over Mullet, Pebley, Foley, and Brew.

In making out the above rejections, the Offices relies on Mullet in each of the contended combinations. Thus, a discussion of Mullet may be helpful. Mullet describes methods and systems for browsing data in a database using a graphic user interface (GUI) that includes a browsing tool. Mullet, Abstract. For example, the browsing tool may be a magnifying glass lens with cross-hairs and a magnifying reticle. FIG. 3A of Mullet shows that the browsing tool may be moved around the data from the database such that the user may magnify an area under the lens to view the area in detail. Mullet, col. 5, lines 56-67. Mullet does not constrain what data may be viewed using the browsing tool. This is to say that Mullet allows a user to freely browse the data within the database (e.g., maps, organizational charts, and so forth) by passing the browsing tool over an area in order to enhance the data. Thus, in FIG. 3A of Mullet, the user may move the browsing tool around the map of San Francisco to enhance any portion of the map.

In making out the rejection of **claim 1**, the Office relies on Mullet as teaching the features of “distorting said *predetermined region* to present said secured information.” Emphasis added. Applicant respectfully disagrees that Mullet alone, or in combination with Pebley teaches these features. In its rejection of claim 1, the Office contends that “[i]t should be noted that Mullet only magnifies a particular area (sic) of the image instead of magnifying the whole image. Thus Mullet teaches the concept of distorting a predetermined region of an image.” Advisory Action, page 2, second paragraph. Emphasis added. Applicant respectfully disagrees.

For the sake of argument only, even if Mullet does teach magnification of a “particular area,” the Office has failed to show how this particular area is “predetermined.” This is to say that the Office has not shown that the particular area (the area under the browsing tool’s magnifying glass) was previously determined, such as before the user selected the particular area. In order for a *prima facie* case of obviousness to exist, the Office is obligated to prove that each feature of the claim is taught by the cited references.

Mullet does not teach “predetermination” because until the browsing tool is placed over an area no determination has occurred. The Office has failed to point to any portion of Mullet that teaches some sort of process or step akin to a predetermination that occurs before the user moves the browsing tool over the particular area to “select” the particular area. Thus, for the sake of argument only, even if Mullet does teach selection of a particular area (e.g., the area under the browsing tool’s lens), the Office has not proven that the particular area has been determined before the user halts the browsing tool to enhance the underlying area. Mullet, Col. 5, lines 56-67. A *prima facie* case of obviousness only exists when the Office proves that the cited combination teaches each and every feature recited in the claim. In the present case, the Office has not shown that the particular area in Mullet is predetermined.

Moreover, the Office’s contention that Mullet’s particular area may be combined with Pebley’s “security aspects” is improper because under the Office’s rationale each area in Mullet over which the browsing tool may be placed would be predetermined. Thus, according to the Office’s rationale, there would be no other region in Mullet and the entire map would be the predetermined region.

The Office has also failed to cite any portion of Mullet or Pebley as teaching or suggesting “secured information in a predetermined region.” In other words, it is not enough for the Office to suggest that Mullet teaches a “predetermined region” and that Pebley teaches “secured information,” the Office must show why one would want to include the secured information in the predetermined region as opposed to some other region. The Office fails to prove this because according to the Office’s rational all the data (e.g., the entire map) in Mullet would be secured and in a predetermined region. For at least the above reasons, removal of rejection to claim 1 is requested and allowance is solicited.

Independent claim 20 is also rejected over Mullet in view of Pebley. Applicant respectfully disagrees that the contended combination of Mullet and Pebley teach or suggest all the features of claim 20.

In making out the rejection, the Office cited Mullet as teaching the features of “determining whether access is authorized to detailed information included in *a predetermined region of an image*.” Emphasis added. Mullet does not teach or suggest

a predetermined region because before a user halts the browsing tool the particular area under the browsing tool has not been predetermined. This is to say that the Office has not proven that Mullet teaches anything akin to a determination that would occur before the user halts the browsing tool to enhance the underlying area. Thus, the Office has failed to establish that Mullet's teaching of a particular area would teach or suggest a predetermined region as is contended by the Office.

Moreover, following the Office's reasoning, in Mullet all of the data would have to be in a predetermined region. For example, in FIG. 3A of Mullet, the entire map of San Francisco would have to be the predetermined region because Mullet allows users to scroll over the entire map to enhance the data. This line of reasoning is also inconsistent because Mullet does not have another region (e.g., of the map) and as a result the term region would lose its ordinary meaning. The teachings of the Pebley reference are not at issue because the Office has neither cited Pebley as correcting these deficiencies nor does Pebley actually correct these deficiencies. Removal of the pending rejection is requested and allowance is solicited.

The rejection of **independent claim 23** is improper because the Office has not proven that Mullet/Pebley teach or suggest all the features recited in claim 23. For example, the Office has not shown where Mullet/Pebley teach or suggest instructions that are executable to "determine whether access is authorized to secured information included *in a predetermined region of an image.*" Emphasis added. Although the Office cited Mullet as teaching a predetermined region, the Office is incorrect because it did not prove that Mullet's particular area was predetermined. Thus, for the sake of argument only, the area under the browsing tool may be a particular area without being predetermined.

As discussed above, the Office is obligated to prove that each and every feature of claim 23 is taught or suggested in order for a *prima facie* case of obviousness to exist. In the case of claim 23, a *prima facie* case of obviousness does not exist because there is no predetermination before the user halts the browsing tool to enhance the area under the tool. Thus, for the sake of argument only, even if halting the browsing tool does teach "determining," Mullet fails to teach anything akin to a predetermination that occurs before the user halts the browsing tool to enhance the underlying data.

Independent claims 29 and 33 are also rejected based on the combination of Mullet/Pebley. Applicant disagrees with the rejection because Mullet fails to teach or suggest a “module to determine whether access is authorized to detailed information in a predetermined region of an image presented on a display” as recited in claim 29. Mullet does not teach the foregoing because Mullet never teaches a module that makes a determination related to a predetermined region of an image, in the case of claim 29. Instead, Mullet teaches that a user may scroll over, for example, a map to enhance details, e.g., see city streets and so forth. At no time, does Mullet teach a module capable of making a determination “whether access is authorized to detailed information in a predetermined region”. Further, following the Office’s rationale, all data, such as the entire map in FIG. 3A of Mullet, would be in a predetermined region because the user is allowed to scroll over the entire map. Mullet, col. 5, lines 46-55. For at least the foregoing reasons, removal of the rejection of claim 29 is requested and allowance is solicited.

Although claim 33 recites features that are different than those of claim 29 and the other independent claims, claim 33 is allowable based on similar rationales. Removal of the rejection to claim 33 is requested and allowance is solicited.

Respectfully Submitted,

Dated: 10/12/09

By: /Nathan Grebasch /
Nathan Grebasch
Reg. No. 48600
Attorney for Applicant